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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,722	03/30/2001	Dale Tyson Roberts	1364.1001D2C	5204
21171	7590	10/21/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			VU, VIET DUY	
			ART UNIT	PAPER NUMBER
			2154	
DATE MAILED: 10/21/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,722

Applicant(s)

ROBERTS ET AL.

Examiner

Viet Vu

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6 and 9-60 is/are rejected.
- 7) ☒ Claim(s) 7 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Art Rejections:

1. The texts of 35 USC 102(e) and 103(a) not cited here can be found in the previous office action.

2. Claims 17-21, 25-26 and 45-60 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hudetz et al, U.S. pat. No. 5,978,773.

Hudetz discloses system and method for obtaining complimentary web content related to a product or article from a remote web server comprising:

a) means for determining the product identifier (col 10, lines 3-20),

b) a communication unit for using the identifier as a key to access a remote database to locate records of related URLs, and for using the located URLs to download the web content (col 7, lines 1-28),

c) means (browser) for outputting the complimentary web content (see col 10, lines 55-67).

3. Claims 2-6, 9-16, 22-24 and 27-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary et al, U.S. pat. No. 5,774,664 and further in view of Hudetz.

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Per claims 2-6, Hidary discloses system and method for associating local and remote data on a computer comprising:

- a) a computer terminal for accessing/playing an audio/video program (see col 4, lines 28-39),
- b) a decoder for determining a plurality of identifiers, i.e., URLs, from information associated with the program (col 5, lines 34-46 and col 6, lines 32-41),
- c) a communication unit for automatically downloading the complimentary content, e.g., web content, from the remote device, e.g., web server, over a network using the identifiers in response to some user's interaction (col 7, lines 11-29),
- d) means for processing/displaying the complimentary content in concurrent with the program (see col 7, lines 60-65).

Hidary also teaches playing the program from a recording medium (see col 9, lines 3 - col 10, line 2).

Hidary does not explicitly show a playback unit for playing program on a recording medium. An official notice is taken that such playback unit is well known in the art.

Hidary does not teach providing a database for storing related URLs. Hudet teaches using of such database to address problems when content providers change their network addresses (see Hudetz's col 4, lines 19-30 and col 7, line 1-28).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hidary with Hudetz's teachings because it would have alleviated the problem of storing/encoding network addresses onto prerecorded media where such addresses could be changed later on (see Hudetz's col 4, lines 19-30).

Per claims 9-12, it would have been further obvious to one skilled in the art to recognize that any complimentary data contents in any conventional formats, e.g. text, audio, video, would have been provided to the recording/program including album titles and song names.

Per claims 13-16, it is noted that the steps of operating/playing a recording, including prompting input of a disc and verifying the access of the disc, are well known in the art.

Claims 22-24 and 27-44 are similar in scope as that of claims 2-6 and 9-16.

Allowable Subject Matter:

4. Claims 7-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Response to Amendment:

5. Applicant's arguments filed on 8/6/04 with respect to claims 2-6 and 9-60 have been fully considered but they are moot in view of new grounds of rejection set forth above.

Conclusion:

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viet Vu whose telephone number is (703) 305-9597. The examiner can normally be reached on Monday through Friday from 7:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee, can be reached on (703) 305-8498.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



VIET D. VU
PRIMARY EXAMINER

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10/18/04